

Application Number 10/587,802
AMENDMENT of October 26, 2009
Response to Office Action of August 24, 2009

REMARKS/ARGUMENT

The Applicants respond under 37 C.F.R. § 1.116 to the Office Action of August 24, 2009.

Claims 9, 12 through 19, and 21 are pending in the application. Claim 21 is amended, and claims 1 through 8, 10, 11, and 20 are canceled. Entry of these amendments is respectfully requested as it is believed they render the claims patentable or in better condition for appeal.

A corrected Terminal Disclaimer accompanies this response. The \$140 official fee was previously charged on June 2, 2009, to Deposit Account No. 15-0700. No additional fee is believed to be due for this purpose.

The Applicants' counsel noticed that the Examiner did not enter the citation of French patent document FR 2 821 718 for not being accompanied by an English-language equivalent. The Applicants request reconsideration.

The French document was cited in the International Search Report, and copies of all documents necessary to consider and enter this citation should have been provided by the International Bureau. The Form 1449 was provided as a convenience for entry of the citations in the search report.

The Applicants attach (1) a copy of the French document, (2) its U.S. equivalent (U.S. Publication No. US2007/0293549 A1), and (3) a new Form 1449. Please note that the citation and the current application are commonly owned by Bayer CropScience S.A.

Application Number 10/587,802
AMENDMENT of October 26, 2009
Response to Office Action of August 24, 2009

No fee is believed to be due because the citation should have been transmitted by the International Bureau and considered by the Examiner. However, if this belief is incorrect, any fee may be charged to Deposit Account No. 15-0700.

Claim 21 is amended by incorporating the features of claims 12 and 14 and to correct what is believed to have been a clerical error ("as to" rather than "and") in the specification and claims as originally filed. The Examiner has acknowledged on page 7 of the current Office Action that claims 12 and 14, as well as claims 13, 15, and 16, are free of the prior art in view of the results provided in the specification that demonstrate synergistic combinations within the instantly claimed ratios. Accordingly, it is submitted that claim 21, as now amended, is also free of the prior art.

1. Rejection under 35 U.S.C. § 103(a)

Claims 9 through 11, 17 through 19, and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 2001/11965 (Cooke et al.) in view of WO 2002/069712 (Holah et al.), and further in view of Colby, 15 WEEDS 202-22 (1967).

Claims 10 and 11 are canceled. Claims 9 and 17 through 19 are all dependent, either directly or indirectly, upon claim 21 which, as noted above, is now amended so as to be free of the prior art. It therefore follows that claims 9 and 17 through 19 are also free of the prior art.

Accordingly, it is requested that the rejection of claims 9 through 11, 17 through 19, and 21 under 35 U.S.C. § 103(a) as being unpatentable over Cooke et al. in view of Holah et al. and further in view of Colby be withdrawn.

Application Number 10/587,802
AMENDMENT of October 26, 2009
Response to Office Action of August 24, 2009

2. Rejection on the Ground of Obviousness-Type Double Patenting

Claims 9 through 19 and 21 are provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 9 through 17 and 19 of U.S. Patent Application No. 10/588,532 in view of Leroux, 47 PEST. SCI. 191-97 (1996).

As pointed out in the Office Action, a timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application.

The present application and U.S. Patent Application No. 10/588,532 are commonly owned by Bayer CropScience S.A., 16 Jean-Marie Leclair, F-69009 Lyon, France.

A Terminal Disclaimer under 37 C.F.R. § 1.321(b) and (c) disclaiming, with the customary exceptions, the terminal part of the statutory term of any patent granted on the instant application that would extend beyond the expiration date(s) of the full statutory term(s) of any patent(s) issued on U.S. Patent Application No. 10/588,532 is filed herewith.

Accordingly, it is requested that the provisional rejection of claims 9 through 19 and 21 on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 9 through 17 and 19 of U.S. Patent Application No. 10/588,532 in view of Leroux be withdrawn.

Application Number 10/587,802
AMENDMENT of October 26, 2009
Response to Office Action of August 24, 2009

3. Rejection under 35 U.S.C. § 112, Second Paragraph

Claims 9 through 19 and 21 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention.

Specifically, according to the Examiner:

Claim 21 cites the following limitation 'as to the N-oxides of 2-pyridine thereof'. It is not certain what is meant by this limitation, as the pyridylethylbenzamide compounds cited in the claim are not N-oxides. Additionally, there are no examples of N-oxide pyridylethylbenzamide compounds in the specification. Therefore, the claim limitations cannot be fully determined and the claim is indefinite. Claims 9-19, which are dependent claims of claim 21, are also rejected for this reason.

As noted above, claim 21 has been amended to correct what is believed to have been a clerical error ("as to" rather than "and") in the specification and claims as originally filed. Thus, the claims are now directed, *inter alia*, to a composition comprising a pyridylethylbenzamide derivative and to the N-oxides of 2-pyridine thereof. It is thus submitted that those skilled in the art will readily understand what is meant by this feature which, of course, is not a limitation but, rather, an extension of the definition of component, and that this language refers to any of the three compounds listed in claim 21 wherein an oxygen atom is bonded to the nitrogen atom of the pyridine ring therein.

Accordingly, it is requested that the rejection of claims 9 through 19 and 21 under 35 U.S.C. § 112, second paragraph, be withdrawn.

Application Number 10/587,802
AMENDMENT of October 26, 2009
Response to Office Action of August 24, 2009

4. Conclusion

In view of the foregoing, it is submitted that this application is now in condition for allowance. Favorable consideration is requested.

Respectfully submitted,



Paul Grandinetti
Registration No. 30,754
OSTROLENK, FABER, GERB & SOFFEN, LLP
1180 Avenue of the Americas
New York, New York 10036-8403
Telephone (212) 382-0700